



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/515,276	02/29/2000	Marc R. Montminy	SALK1650-2	1983

7590

12/17/2001

STEPHEN E. REITER
FOLEY & LARDNER
402 W. BROADWAY
23RD FLOOR
SAN DIEGO, CA 92101

EXAMINER

WORTMAN, DONNA C

ART UNIT

PAPER NUMBER

1648

DATE MAILED: 12/17/2001

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/515,276

Applicant(s)

MONTMINY, MARC R.

Examiner

Donna C. Wortman, Ph.D.

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 12 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 12 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

Art Unit: 1648

Claims 1, 5, 12, and 17 were amended in Paper No. 7. Claims 1-7, 12 and 17 are under examination.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 is indefinite in reciting "said biological system is an intact organism" without antecedent in claim 1 which now recites "an individual."

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-7, 12 and 17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, essentially for the reasons made of record at page 3 of the previous Office action.

Applicant has asserted that the basis for the rejection for lack of enablement rests solely on the cited portion of the Merck Manual, which describes only well known therapeutic approaches, and cites recently issued US patents as showing more recent approaches to diabetes treatment. Applicant has submitted publications by Mayr et al.

and Herzig et al. in support of the feasibility of the claimed method for treating diabetes, which Applicant refers to as "quite new."

These arguments and the supporting documents have been considered but not found persuasive. The Merck Manual was cited in order to provide one indication of the state of the art at or about the time the invention was made; it is appropriate to take into account the state of the art when considering the issue of enablement. The U.S. patents cited by Applicant provide other indications of the state of the art. It is presumed that the claims of these patents are enabled by their own specifications; however, since Applicant has not pointed out any particular portions of these patents that are alleged to support enablement of the instant claims, they are not seen to provide factual evidence for enablement. The Mayr et al. and the Herzig et al. references, both published in 2001, well after the effective filing date of the instant application, use methods to obtain results that go beyond those instantly disclosed. Even taking into account the results disclosed in the Mayr et al. and the Herzig et al. references, it is apparent that the state of the relevant art has not developed to the point that one of skill in the art would know how to treat diabetes based on Applicant's disclosure. Though Applicant discloses a screening method for identifying candidate agents, not one agent is disclosed that both has the binding-inhibitory effect required and is effective to treat a human with diabetes, although human treatment is clearly contemplated. Determining that disrupting a particular complex represents a "feasible" treatment is not equivalent to teaching one of skill in the art how to administer a compound that disrupts the complex and thereby to treat a disease condition. As of

Art Unit: 1648

September 2001, the Herzig et al. reference illustrates both the state of the art and the inherent unpredictability in the field: "The effect of A-CREB on liver gene expression suggests that CREB **may** constitute an ideal target for therapeutic intervention.

Although use of a dominant negative inhibitor such as A-CREB may not be feasible in this regard, small molecules that block CREB phosphorylation or disrupt recruitment of the CREB coactivator CBP (CREB binding protein) **may** prove effective. Such compounds **may** be particularly beneficial as adjunctive therapy in lowering fasting blood glucose levels in type II diabetes." (See page 182, second column, second full paragraph; emphasis added.)

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 1648

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donna C. Wortman, Ph.D. whose telephone number is 703-308-1032. The examiner can normally be reached on Monday-Thursday, 7:30-5:00 and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on 703-308-4027. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Donna C. Wortman, Ph.D.
Primary Examiner
Art Unit 1648

dcw
December 14, 2001